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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,233	07/28/2000	Stephen J. Boies	YOR9-2000-0265(1963-4980)	3417

28062 7590 07/15/2003

BUCKLEY, MASCHOFF, TALWALKAR, & ALLISON
5 ELM STREET
NEW CANAAN, CT 06840

EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<h1>Office Action Summary</h1>	Application 09/628233	Applicant(s) Boies	
	Examiner Hans G	Art Unit 3644	Confirmation No.

- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6/30/03
- ☒ This action is **FINAL**. ☐ This action is non-final.
- ☐ Since this application is in condition for allowance except for the formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-38, 43-51 is/are pending in this application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-38, 43-51 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved or ☐ disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.
- ☐ The drawing(s) filed on _____ is/are ☐ accepted or ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d) or (f).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received:

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- ☐ The translation of the foreign language provisional application has been received.
- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Response to Amendment

1. This action is issued in response to applicant's Amendment B(Paper #11) filed 6/30/03.
- 2.No further claims were amended. None were deleted. None were added.
3. Claims 1-38, 43-51 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-38, 43-51 are rejected under 35 USC 103(a) as unpatentable over Friedland(US Pat. No: 6,449,601) in view of in view of Anderson(US Pat. No: 6,510,434).
6. As per claims 1-51 Friedland teaches a method of decentralized e-commerce(Abstract) comprising conducting auctions over the Internet(Fig 4) for the sale of merchandise(Fig 7/710/716) and offering the user the opportunity to purchase the merchandise(Fig 7/726) for auction(Fig 6/622/606). Friedland also describes the merchandise by price(Fig 8/808) as well as a means offered to the user to purchase the merchandise(Fig 8/818) as well as rejecting the bids that do not meet a minimum bid threshold(Fig 8/806). Anderson teaches(col 2 line 36-col 3 line 43) wherein the portal tagging standard requires tags(col 8 line 65-col 9 line 64) for domains and

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categories(Fig 6A)(Fig 5) which may include name,address,education, experience and job classification(Abstract)(Fig 3A)(Fig 3B)(Fig 4B)(as well as providing a link to the matching content(Fig 5)(Fig 8)(col 2 line 36-col 3 line 39). Anderson also relates providers for parts and items associating each provider with an item(Fig 2)(col 8 lines 28-64) as well as conducting search queries using tags(Fig 6C) and sending search requests to servers(Fig 7) and parsing search requests from clients to identify terms(Fig 8) as well as delivering search results to clients. It would have been obvious to one skilled in the art at the time of the invention to combine Friedland in view of Anderson to teach the invention. The motivation to combine is to teach a system for providing improved searching for matching items as applied to e-commerce as enunciated by Anderson(col 2 lines 25-34).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 43-45 are further rejected under 35 USC 101 as failing to provide a concrete, useful and tangible output. A computer medium with code by itself defines no functionality.

Response to Arguments

9. Applicant's arguments with respect to claims cited have been considered but are not persuasive. Anderson teaches(col 2 line 36-col 3 line 43) wherein the portal tagging standard requires tags for domains and categories(Fig 6A) which may include name,address,education,

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experience and job classification(Abstract)(Fig 3A)(Fig 3B)(Fig 4B)(as well as providing a link to the matching content(Fig 5)(Fig 8)(col 2 line 36-col 3 line 39).Anderson also relates providers for parts and items associating each provider with an item(Fig 2)(col 8 lines 28-64) as well as conducting search queries using tags(Fig 6C) and creating indeces(Fig 5) and sending search requests to servers(Fig 7) and parsing search requests from clients to identify terms(Fig 8) as well as delivering search results to clients.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00

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PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA


July 14, 2003

DR. GEOFFREY R. AKERS, PE
PRIMARY EXAMINER

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